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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,105	01/17/2002	Kenji Hatada	360842007400	1303

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Barry E Bretschneider  
Morrison & Foerster  
2000 Pennsylvania Avenue N W  
Washington, DC 20006-1888

EXAMINER

KRUER, KEVIN R

ART UNIT PAPER NUMBER

1773

10

DATE MAILED: 05/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/787,105	HATADA, KENJI
	Examiner Kevin R Kruer	Art Unit 1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 19 March 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-3,5 and 7-22 is/are pending in the application.

4a) Of the above claim(s) 12-21 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-3, 5, 7-11 and 22 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1, 3, 5, 7-11, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama et al (US 5,182,171) in view of Takemura et al (US 4,763,133). Aoyama teaches a steel sheet comprising steel having an average roughness of 0.01-2.0um, and a coating film applied thereon that has a dry thickness of 18-110% of the surface roughness (abstract). Thus, the coating film may have a thickness of 0.002-2.2um. The coating provides the steel with good corrosion resistance (col 3, lines 44+). The steel may comprise an alloy-plated steel (col 2, lines 40+). When alloy plated steel is the substrate, the examiner takes the position that the plating reads on the claimed metal deposited layer and the steel reads on the claimed base material.

Aoyama does not teach that the coating layer can comprise the claimed polymer resin layer. However, Takemura teaches that industrial paints are widely applied to metals in order to provide the metal with improved corrosion resistance (col 4, lines 64+). Industrial paints include (a) an alkyd resins and (b) polyurethane paints. Alkyd resins are prepared by condensation of polybasic acids and polyhydric alcohols (col 6, lines 4+), including those prepared by modifications using vegetable oils such as linseed oil, tung oil, castor oil, sunflower oil, soybean oil, and coconut oil can be used. Available two-component polyurethane paints are prepared by reacting dry oils (e.g., soybean

oils, linseed oils, or castor oils) with a polyester or polyether and further with isocyanate compounds (col 9, lines 1+). It would have been obvious to one of ordinary skill in the art to utilize the industrial paints taught in Takemura as the coating layer taught in Aoyoma because said paints are functionally equivalent to the coating layers taught in Aoyoma in that they improve the laminate's corrosion resistance.

With respect to claim 11, the examiner takes the position that the steel sheet has the conductive "property of a metallized film for a capacitor."

2. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama et al (US 5,182,171) in view of Takemura et al (US 4,763,133), as applied to claims 1, 3, 5, 7-11, and 22 above, and further in view of Cichanowski (US 4,499,520). Aoyama in view of Takemura is relied upon as above, but does not teach that the steel sheet can be coated with a dielectric composition. However, Cichanowski teaches an electrical capacitor comprising two electrodes separated by a dielectric member, said dielectric member comprising a polymer of at least one polyfunctional acrylate (abstract). The polyfunctional acrylate comprises a polymer of formula (I) (col 2, lines 11+). It is frequently convenient to prepare such polyhydroxy compounds by reduction of at least one corresponding polycarboxylic acid or ester thereof, which may be saturated or may contain olefinic linkages. A typical suitable polycarboxylic acid is linoleic acid dimer (col 5, lines 47+). The dielectric member is utilized in thickness of 3-6 microns (col 10, lines 27+). The electrodes may comprise stainless steel (col 2, lines 29+). It would have been obvious to one of ordinary skill in the art to apply the dielectric composition taught

in Cichanowski to the coated steel sheet taught by Aoyama in view of Takemura so that the sheet may be utilized in capacitors.

***Response to Arguments***

Applicant's arguments with respect to claims 1-3, 5, 7-11, and 22 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 703-305-0025. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

*K-RH*

krk  
May 7, 2003

*Paul Thibodeau*  
Paul Thibodeau  
Supervisory Patent Examiner  
Technology Center 1700